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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------|
| 09/708,129 | 11/07/2000 | David N. Spiegel | END920000101US1 | 1094 |
| 45092 | 7590 | 05/31/2005 | EXAMINER RUTTEN, JAMES D | |
| HOFFMAN, WARNICK & D'ALESSANDRO LLC THREE E-COMM SQUARE ALBANY, NY 12207 | | | ART UNIT 2192 | PAPER NUMBER |
| DATE MAILED: 05/31/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/708,129

Applicant(s)

SPIEGEL, DAVID N.

Examiner

J. Derek Rutten

Art Unit

2192

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-18.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


WEI Y. ZHEN
PRIMARY EXAMINER

Continuation of 3. NOTE: Applicant's amendments, appearing in independent claims 1, 9, 17 and 18, raise issues requiring further search and consideration. Further, applicant has not provided a showing of good and sufficient reasons why the amendments are necessary and were not earlier presented.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues at the top of page 11 that "Stupek fails to disclose, inter alia, starting in said second host session a database application having a database of all known second maintenance items." However, this limitation contains new language requiring further search and consideration. Further in the same paragraph, Applicant makes an attribution to the Office action as follows: "However, as admitted by the Office, the upgrade database entries in Stupek are limited to data regarding each upgrade package, and, as such, Stupek does not teach that the database includes all known second maintenance items. Office Action, page 3, par. 5." Review of the prior Office Action did not reveal such an admission.

At the top of page 12, Applicant appears to argue a deficiency in the Stupek reference. However, it is not clear from the argument how the language of the claims is distinguished from the reference. Thus, the argument is not convincing. In the last sentence of the same paragraph at the top of page 12, applicant argues that "Stupek never teaches that the 'upgrades' are compared to entries in the upgrade database." However, Stupek discloses this feature in column 4 lines 20-27 as cited in the prior Office action on page 7.

At the bottom of page 12, applicant argues that "Stupek does not specifically teach that the upgrade database is searched using a separate list of new upgrades..." However, the feature of "searching the database using a separate list of new upgrades" is not recited in the claims. Thus, this argument is not convincing.

At the bottom of page 13, applicant argues that "the cited references do not include adding said corresponding prerequisite items and corequisite items to said first list". However, Stupek discloses a first list, and the Taylor reference teaches adding dependency information to a list as recited in the previous Office action on page 10.

In the second paragraph on page 14, application argues that the references do not teach "thereafter ordering, receiving, and applying..." However, this limitation contains new language requiring further search and consideration.